

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Richard H. Harvey
Serial No.: 09/844,043
Filing Date: April 27, 2001
Confirmation No. 2690
Group Art Unit: 2162
Examiner: Jean M. Corrielus
Title: *System and Method for Operating a Database*

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pre-Appeal Brief Request for Review

This Pre-Appeal Brief Request for Review and the accompanying Notice of Appeal are submitted pursuant to provisions set forth in the Official Gazette Notice of July 12, 2005. Applicant respectfully requests reconsideration of the rejected claims.

Remarks

Claims 1, 4-9, 12-17, 20-22, 24-28, and 31-36 stand rejected pursuant to a Final Office Action mailed October 11, 2007 ("Final Office Action"). Applicant mailed a Response to the Final Office Action on December 11, 2007 ("Final Response"). The Examiner mailed a first Advisory Action on January 9, 2008, ("First Advisory Action"), which indicated that "an office action will [be] forthcoming." The Examiner mailed a second Advisory Action on January 10, 2008, ("Second Advisory Action"), which indicated among other things that "no office action is required."

The Examiner's rejections and assertions in the Final Office Action contain clear errors of law. In the Final Office Action, the Examiner objects to Claims 1, 5, 9, 13, 17, 28, 32, and 36 for various informalities, and rejects Claims 1, 4-9, 12-17, 20-22, 24-28, and 31-36 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. For at least the reasons set forth below, the Examiner's objections and rejections should be reversed.

I. The Claim Objections should be Withdrawn

The Examiner objected to the use of the word "it" in Claims 1, 5, 9, 13, 17, 28, 32,

and 36. (Final Office Action at 3)¹ Applicant respectfully traverses this objection.

For example, independent Claim 1 recites the limitations:

- applying a condition test to each filter item of the filter, the condition test comprising:
 - determining* if the filter item comprises a NOT connective; and
 - determining* if the filter item comprises one of a type only filter item or a type and value filter item; and
- *if it is determined* that the filter item comprises a NOT connective and a type only filter item, applying a logical methodology to evaluate the filter item, the logical methodology comprising expanding an expression of the filter item so that the filter item does not comprise the NOT connective.

The phrase “if it is determined” plainly refers to the determinations recited in the first of the above-listed elements of Claim 1. In fact, Applicant believes that using the term “it” actually provides more clarity than if the substance of the two determinations were recited again in full in the second of the above listed elements Claim 1, which would make the claim more burdensome to read and understand. The use of the term “it” in dependent Claim 5, as well as in independent Claims 9, 17, 28, and 36 and their dependent claims, is similarly clear.

Although Applicant believes the word “it” is appropriate, in the Final Response Applicant proposed clarifying amendments to Claims 1, 5, 9, 13, 17, 28, 32, and 36 to remove the word “it.” For example, Applicant proposed amending the last limitation of Claim 1 to recite “if a determination is made that” rather than “if it is determined that.” Even though these amendments would plainly place the case in better condition for allowance (at least in the Examiner’s view) or Appeal (by removing issues for Appeal), the Examiner declined to enter these amendments without providing any particular explanation as to why. (See Second Advisory Action)

Applicant respectfully requests that the Examiner be instructed to withdraw the objections to Claims 1, 5, 9, 13, 17, 28, 32, and 36 because this use of the term “it” is acceptable, or that the Examiner be instructed to enter the proposed amendments, which would obviate the Examiner’s objections to Claims 1, 5, 9, 13, 17, 28, 32, and 36.

The Examiner also objected to the use of the phrase “can be” in Claims 6-7, 14-16, and 33-35. (Final Office Action at 3) Applicant traverses this objection, discussing Claim 6 as an example. Claim 1 recites a method that comprises applying a condition test that comprises limitations recited in Claim 1 (*i.e.*, “determining if the filter item comprises a NOT

¹ This current objection to the use of “it” has been asserted as a rejection (*see* Office Action mailed February 17, 2006), then withdrawn and the claims allowed (*see* Notice of Allowance and Fees due mailed June 2, 2006), then reasserted as a rejection (*see* Office Action mailed September 28, 2006), then withdrawn (*see* Office Action mailed April 11, 2007), and then reasserted as an objection (*see* Final Office Action).

connective” and “determining if the filter item comprises one of a type only filter item or a type and value filter item”). Claim 6 depends from Claim 1 and recites that the condition test “further comprises determining if each filter item can be pre-evaluated to true.” One of ordinary skill in the art would understand from the plain meaning of Claim 6 that the condition *test* of Claim 1 further comprises making the determination recited in Claim 6. In particular, the condition *test* of Claim 1 further comprises determining if each filter item *can be* pre-evaluated to true. It would have to be at least possible to pre-evaluate a filter item to true (in contrast to those filter items that cannot be pre-evaluated to true) for the portion of the condition test recited in Claim 6 to be met for that filter item. The Examiner’s statement that “‘can be pre-evaluated’ to true raises questions as to whether the filter item can actually be pre-evaluated to true” merely identifies the very determination being added by Claim 6.

Although Applicant believes the phrase “can be” is proper for at least those reasons discussed above, in the Final Response Applicant proposed clarifying amendments to Claims 6-7, 14-16, and 33-35 to remove the phrase “can be.” Even though these amendments would plainly place the case in better condition for allowance (at least in the Examiner’s view) or Appeal (by removing issues for Appeal), the Examiner again declined to enter these amendments without providing any explanation as to why. (*See Second Advisory Action*)

Applicant respectfully requests that the Examiner be instructed to withdraw the objections to Claims 16-7, 14-16, and 33-35 because this use of the phrase “can be” is acceptable, or that the Examiner be instructed to enter the proposed amendments, which would obviate the Examiner’s objections to Claims 6-7, 14-16, and 33-35.

II. The Claims Recite Patentable Subject Matter

The Examiner rejects Claims 1, 4-9, 12-17, 20-22, 24-28, and 31-36 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully disagrees.

With respect to independent Claims 1, 9, 17, 28, and 36, the Examiner stated the following in the non-final Office Action mailed April 11, 2007 (at page 4):

Claims 1, 9, 17, 28 and 36 recite “if it is determined that the filter item comprises a NOT connective and a type only filter item, apply a logical methodology to evaluate the NOT connective, the logical methodology comprising expanding an expression of the filter item so that the filter item does not comprise the NOT connective” could be reasonably considered a tangible and useful result when the dirty data items are selected, it appears to have no claimed result in the condition when the filter items does not comprise a NOT connective; and when the filter item does not comprise one of a type only filter item or a type and value filter item to form the basis [for] statutory subject matter under 35 U.S.C. 101.

According to the M.P.E.P., “[t]he claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” M.P.E.P. ch. 2106(II)(a). “The purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research. M.P.E.P. ch. 2106(II)(A)

The Examiner essentially is requiring the claims to recite each possible outcome of the determinations made in Claim 1 (for example) for the claim to be statutory. Although initially providing no alleged support for this requirement, in the Final Office Action, the Examiner cited the U.S.P.T.O.’s Interim Guidelines for Subject Matter Eligibility as purportedly supporting the Examiner’s position. (Final Office Action at 2) After reviewing these Guidelines, Applicant’s attorney finds no requirement that each possible outcome of a determination be recited in a claim for the claim to be statutory. For example, even assuming that the useful, concrete, and tangible result is the appropriate test for these claims, Applicant’s attorney does not find in the Guidelines any *per se* rule requiring Applicant to state each outcome of a conditional test in a claim for the claim to recite a useful, concrete, and tangible result, and to be statutory. In any event, all that the law requires is that a claim recites *a* useful, concrete, and tangible result to be statutory. The rejected independent claims do so. Therefore, Applicant submits that the claims are directed to patentable subject matter.

In the Second Advisory Action, the Examiner does not respond to these arguments but simply asserts a new basis for the Section 101 rejection – a basis which has absolutely no relationship to the basis for the 101 rejections presented in the previous Office Actions.²

In the Advisory Action, the Examiner states, “Claim 36 recite[s] software being embodied in a computer readable. According to the specification page 9, such computer readable is a code or software. ***It appears that software [does] not fall within a statutory category of invention.***” (Second Advisory Action, Continuation Sheet) (emphasis added) Notwithstanding the fact that this statement does not address any of Applicant’s above-discussed arguments (presented in prior Responses to Office Actions), does not address the rejection of most of the independent claims, and provides a whole new basis for the rejection of one claim, Applicant submits that the new basis for rejecting Claim 36 also lacks merit.

² In fact, the Examiner’s reason for refusing to enter Applicant’s amendments proposed in the Final Response (which related only to the Examiner’s *objections*) only related to Claim 36 and not to all claims rejected under Section 101. (Second Advisory Action)

The Examiner cites no authority for the proposition that claims directed to software are not a process, a machine, a manufacture, or a composition of matter. The United States Court of Appeals for the Federal Circuit has recently stated that 35 U.S.C. § 101 “explains that an invention includes ‘any new and useful process, machine, manufacture or composition of matter.’ *Without question, software code alone qualifies as an invention eligible for patenting* under these categories, at least as processes.” *Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338-39 (Fed. Cir. 2005) (citations omitted) (emphasis added). Claim 36 is directed to software embodied in computer-readable medium that when executed is operable to perform the limitations recited in the body of the claim. Appellants respectfully submit that Claim 36 is plainly statutory.

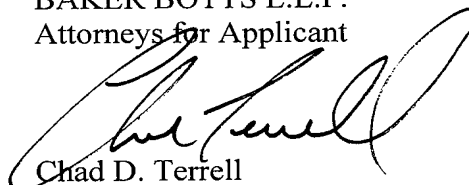
Moreover, the M.P.E.P. states that “functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component.” M.P.E.P. ch. 2106.01. “When functional descriptive material [*i.e.*, computer programs, according to above-cited portion of the M.P.E.P.] *is recorded on some computer-readable medium*, it becomes structurally and functionally interrelated to the medium *and will be statutory in most cases* since use of technology permits the function of the descriptive material to be realized.” *Id.* (emphasis added). The M.P.E.P. plainly contemplates and, in fact, authorizes claims directed to software embodied in a computer-readable medium and operable to perform certain functions. The manner in which Applicant has Claims 36 is clearly contemplated by the M.P.E.P. as being statutory.

For at least these reasons, Applicant submits that Claims 1, 4-9, 12-17, 20-22, 24-28, and 31-36 recite patentable subject matter and requests reversal of the Examiner’s rejections.

Conclusion

For at least these reasons, the Examiner’s objections and rejections contain clear errors of law, and Applicant respectfully requests allowance of all pending claims. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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